

1/19/01

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. EJS

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Joseph Nuzzolo**

Serial No. 75/345,465

Yate K. Cutliff of Pendorf & Cutliff for Joseph Nuzzolo.

Shaunia P. Wallace, Trademark Examining Attorney, Law Office 107 (Thomas Lamone, Managing Attorney).

Before Sams, Seeherman and Hairston, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Applicant has appealed from the Examining Attorney's refusal to register, on the Supplemental Register, THE SALVADOR DALI SOCIETY as a service mark for "art appraisal services, namely, criticism, review, authentication and valuation in the field of Salvador Dali artwork."¹ The

¹ Application Serial No. 75/345,465, filed on the Principal Register on August 22, 1997 and amended to the Supplemental Register on October 13, 1998. Applicant has asserted first use and first use in interstate commerce on March 7, 1997. It is noted that applicant's amendment to the Supplemental Register and the identification of services, his disclaimer of SALVADOR DALI,

words SALVADOR DALI have been disclaimed. Although the examination of this application has been somewhat complicated, registration has been finally refused pursuant to Section 2(a), 15 U.S.C. 1052(a), on the ground that the mark falsely suggests a connection with, as stated in the Examining Attorney's brief, the artist Salvador Dali; and pursuant to Section 2(d), 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark SALVADOR DALI MUSEUM, with the word MUSEUM disclaimed, previously registered for "museum services; educational services, namely, classes in fine art,"² as to be likely to cause confusion or mistake or to deceive.³

Applicant and the Examining Attorney have filed briefs;⁴ an oral hearing was not requested.

and his withdrawal of the previously submitted disclaimer of SOCIETY, all filed on October 13, 1998, had not been entered into the U.S. Patent and Trademark Office's data base. That oversight has now been corrected.

² Registration No. 1,692,000, issued June 9, 1992; Section 8 affidavit accepted; Section 15 affidavit received. The registration was originally issued to The Salvador Dali Foundation, Inc. and subsequently assigned to the Salvador Dali Museum, Inc.

³ It is noted that the Examining Attorney originally cited three additional registrations, all for SALVADOR DALI MUSEUM, and all owned by the Salvador Dali Museum, Inc. Although the Examining Attorney never formally withdrew these citations, applicant has during the prosecution of his application and in his appeal brief treated the Section 2(d) refusal as referring only to Registration No. 1,692,000, and the Examining Attorney's brief makes clear that this is the sole basis for the Section 2(d) refusal.

⁴ With his brief applicant submitted certain materials. Trademark Rule 2.142(d) provides that the record in the

We turn first to the refusal pursuant to Section 2(a). Section 2(a) prohibits, inter alia, the registration of a mark which consists of or comprises matter which may falsely suggest a connection with persons, living or dead, or institutions.

As stated above, in her appeal brief the Examining Attorney contends that applicant's mark falsely suggests a connection with the dead artist Salvador Dali. However, we note that in the Office action in which the Examining Attorney first raised the refusal she stated that applicant's mark created a false association with "the registered marks." Then, in the Office action making this refusal final, the Examining Attorney stated that applicant's mark may falsely suggest a connection with the marks of the registrant and Salvador Dali. (emphasis added). In the paragraph explaining this refusal the Examining Attorney asserted that "the fame of Salvador Dali and the Salvador Dali Museum is so widely known that one would associate THE SALVADOR DALI SOCIETY with the SALVADOR DALI MUSEUM and foundation." February 2, 2000 Office action.

application must be complete prior to the filing of the appeal. Accordingly, these untimely submissions have not been considered.

In support of the position taken in the February 2, 2000 Office action that applicant's mark falsely suggests a connection with the registrant as the Salvador Dali Foundation or Salvador Dali museum, she submitted various articles taken from the NEXIS data base about the Salvador Dali Museum and the Gala-Salvador Dali Foundation.

However, we note that the SALVADOR DALI MUSEUM which the NEXIS evidence refers to, and which the Examining Attorney asserts is famous, is located in Fugueras, Spain, while the registrant's museum, as shown by the registration data and the website evidence made of record by the Examining Attorney, is located in St. Petersburg, Florida. Moreover, the Gala-Salvador Dali Foundation, according to the NEXIS evidence, is a Spanish government body that runs the museum in Spain, while The Salvador Dali Foundation, which obtained the cited registration, is an Ohio corporation.

In order to prove that a mark falsely suggests a connection with a person or institution it must be shown that the mark (or portion of it) points uniquely to that entity. As the Court explained in **University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.**, 703 F.2d 1372, 217 USPQ 505, 598 (Fed. Cir. 1983), "the initial and critical requirement is that the name (or an equivalent thereof) claimed to be appropriated by another must be

unmistakably associated with a particular personality or 'persona,'" (finding that NOTRE DAME is a name not solely associated with the University, but identifies a famous religious figure and is used in the names of churches dedicated to Notre Dame).

The Examining Attorney has failed to show that THE SALVADOR DALI SOCIETY points uniquely to the artist Salvador Dali. In fact, her own statements raise a question as to whether THE SALVADOR DALI SOCIETY points to the artist, the registrant's museum in Florida, the registrant's trademark, or the museum and foundation in Spain. Based on this record, we cannot find that THE SALVADOR DALI SOCIETY points uniquely to the artist, or indeed to any single entity, and therefore the refusal pursuant to Section 2(a) must be reversed.

This brings us to the refusal under Section 2(d) of the Act. The Examining Attorney asserts that applicant's mark THE SALVADOR DALI SOCIETY for "art appraisal services, namely, criticism, review, authentication and valuation in the field of Salvador Dali artwork" is likely to cause confusion with SALVADOR DALI MUSEUM for "museum services."⁵

⁵ The registration also includes "educational services, namely, classes in fine art" in its identification. However, because the Examining Attorney has not discussed these services, we have assumed that it is applicant's use of its mark vis-à-vis the use

In determining whether there is a likelihood of confusion between two marks, we must consider all relevant factors as set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Each of the factors may from case to case play a dominant role. **Kellogg Company v. Pack'em Enterprises, Inc.**, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

In this case, the sophistication of the consumers of applicant's services, and the care with which such services are purchased, play a dominant role. Applicant's services are art appraisal services (criticism, review, authentication and valuation) in the field of Salvador Dali artwork. It is clear from the identification that applicant appraises works created by, or purported to be created by, the artist Salvador Dali. The consumers for these services would typically be people who own art by Salvador Dali and wish to have it valued, or people who are interested in purchasing art by Salvador Dali and wish to have it authenticated. Because of the cost/value of works by Dali, the bona fides of an appraiser are very important, and consumers for the appraisal services will be extremely careful about selecting a person or company to appraise the

of the registered mark for museum services which she believes is likely to cause confusion.

art work. They are not likely to find an art appraiser by simply looking in the yellow pages, but will make their choice after careful research. Moreover, such consumers will be knowledgeable about the art world in general and about the works of Dali in particular. They are likely to know of the SALVADOR DALI museum in Spain, as well as the SALVADOR DALI MUSEUM in Florida, and know that they are run by different entities. They are not likely to assume that every mark that includes the words SALVADOR DALI indicates a common source for the services with which the mark is used, even if the services are related.

Moreover, the only words common to both marks, SALVADOR DALI, are clearly descriptive of both registrant's and applicant's services, as shown by the fact that the registered mark was issued pursuant to the provisions of Section 2(f), and applicant's identification states that his services relate to the artwork of Salvador Dali. (He has also disclaimed these words). On the current record, the registered mark cannot be considered a strong mark which enjoys a broad scope of protection.

We recognize that the involved marks are similar, in that they both contain the words SALVADOR DALI, and the additional word in the registrant's mark, MUSEUM, is generic for its services, while in applicant's mark the

word SOCIETY has relatively little source-indicating significance and the word THE has none. However, for the reasons discussed above, when the marks are compared in their entireties, the differences in the marks are sufficient to avoid the likelihood of confusion.

We would point out that we have made our decision based on the rather limited record before us in this ex parte proceeding. On a more extensive record, such as may be adduced in an inter partes proceeding, we might well come to a different conclusion.

Decision: The refusals based on Section 2(a) and Section 2(d) are reversed.